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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/550,025 | 09/23/2005 | Seiji Tanimoto | 277030US0PCT | 7360 |
| 22850 | 7590 | 01/28/2009 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | BERNSHTEYN, MICHAEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1796 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 01/28/2009 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/550,025 | TANIMOTO ET AL. | |
| | Examiner | Art Unit | |
| | MICHAEL M. BERNSHTEYN | 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 October 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 1-5 and 13-20 is/are allowed.
 6) Claim(s) 6-12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 23 September 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08/2008</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This Office Action follows a response filed on October 22, 2008. Claims 1-5 have been amended; claims 14-20 have been added; no claims have been cancelled.
2. In view of the amendment(s) and remarks the rejection of claims 1,2 and 4 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tanimoto et al. (U. S. Patent 6,495,623); the rejection of claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al. (U. S. Patent 6,495,623) in view of Tanimoto et al. (U. S. Patent 6,451,898), and the rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al. (U. S. Patent 6,495,623) in view of Tanimoto et al. (JP-2002-308939) have been withdrawn.
3. Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al. (U. S. Patent 6,495,623) in view of Tanimoto et al. (JP-2002--08939), for the rationale recited in paragraph 3 of Office action dated on July 22, 2008.

Allowable Subject Matter

6. Claims 1-5 and 14-20 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The present claims are allowable over the closest reference: Tanimoto et al. (U. S. Patent 6,495,623) in view of Tanimoto et al. (U. S. Patent 6,451,898).

Tanimoto et al. do not disclose or fairly suggest that the film resulting from the emulsion displays lower dissolutions less than 10% when dipped in an aqueous 1N sodium hydroxide solution at 20⁰C for 24 hours, as per newly amended claim 1.

7. As of the date of this Notice of Allowability, the Examiner has not located or identified any reference that can be used singularly or in combination with another reference including Tanimoto et al. to render the present invention anticipated or obvious to one of ordinary skill in the art.

In the light of the above discussion, it is evident as to why the present claims are patentable over the prior art.

Response to Arguments

8. Applicant's arguments, see remarks, filed October 22, 2008, with respect to claims 1-5 and 13 have been fully considered and are persuasive. The rejection of claims 1-5 and 13 has been withdrawn.

9. Applicant's arguments filed see remarks, filed October 22, 2008, with respect to claims 6-12 have been fully considered but they are not persuasive.

10. It appears that the focal Applicants argument resides in the contention that Tanimoto'623, discloses films based on the resin emulsions of this reference that have low water resistance bonding strength to lumber values (e.g. 7 kg/cm² of Example 2). In

contrast, films resulting from the presently claimed emulsions display higher film strength values (from 130 to 165 kg/cm²), as shown above in Table 1. On the other hand, Tanimoto'939 discloses an emulsion produced by a method similar to Comparative Example 9 of the present application. Therefore, one of skill in the art would not form resin emulsions from the presently claimed processes based on the disclosure of these references (page 10, 2nd paragraph).

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., films resulting from the presently claimed emulsions display higher film strength values) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the claims 6-12 do not contain the limitation of the dissolution of said film as newly amended claim 1.

Therefore, the rejection of claims 6-12 cannot be withdrawn and remains in force.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/
Primary Examiner, Art Unit 1796

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796